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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,714	03/28/2006	Puthupparampil V Scaria	INTM/016	8393
1473	7590	10/04/2007	EXAMINER	
ROPES & GRAY LLP			WOLLENBERGER, LOUIS V	
PATENT DOCKETING 39/361				
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NEW YORK, NY 10036-8704			PAPER NUMBER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/523,714

**Applicant(s)**

SCARIA ET AL.

**Examiner**

Louis V. Wollenberger

**Art Unit**

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-45 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-20, drawn to a method for down regulating a pre-selected endogenous gene in a mammal, comprising administering a composition comprising a double-stranded RNA molecule. Election of this group requires the further election of a single type of dsRNA molecule (long or short) from claims 2-4; a single type of composition (polymeric or targeted synthetic vector) from claims 12-16; and a single type of mutated gene (coding or regulatory region) from claim 19, as explained below.

Group II, claim(s) 21-33, drawn to a method for down regulating a pre-selected endogenous gene, comprising administering a vector composition encoding an RNA transcript. Election of this group requires the further election of a single type of vector from claim 22; a single class of gene from claim 23; as single promoter from claim 27; a single type of electric pulse from claims 28-30; and a single type of electrode from claims 31 and 32, as explained below.

Group III, claim(s) 34-45, drawn to a method for treating a disease in a mammal, comprising applying a nucleic acid composition and a pulsed electric field. Election of this group requires the further election of a single tissue from claim 36; a single type of nucleic acid from claims 37-41; should applicant elect a vector, a single type of vector from claims 41 and 42; a single class of gene from claim 44; and a single gene from claim 45, as explained below.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of Groups I-III is a method for inhibiting gene expression and treating disease comprising administering a dsRNA or expression vector encoding a dsRNA. However, this cannot be the special technical feature, because the feature is known and/or obvious in view of the prior art. For example, Tuschl et al. (US 20040259247 A1) taught methods and materials for making and using short interfering RNA of 19-25 nucleotides in length for inhibiting the expression of virtually any known gene in cells in vitro and in vivo for research and therapeutic purposes. Similarly, Beach et al. (US 20020162126 A1) taught methods and materials for making and using expression vectors

encoding short interfering RNA in cells in vitro and in organisms for investigating gene function as it relates to disease. Accordingly, Groups I-III lack unity of invention *a posteriori*.

***Further Restriction to a single inventive concept***

Groups I, II, and III each contains claims directed to a plurality of inventions. These inventions are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In particular, the inventions are distinguished by those special technical features listed above (see underlined Further Restriction under each Group). Each feature, listed above, represents a different special technical feature unique to the method comprising and/or requiring that feature. Inasmuch as each feature defines a separate and unique method, and the feature is not present in any other method within that group, the methods as a whole lack unity of invention *a priori*.

Applicant is required, in reply to this action, to elect a single method, comprising a single inventive concept, to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected invention, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic linking claim, applicant will be entitled to consideration of claims to additional inventions which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected inventions. MPEP § 809.02(a).

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The claims deemed to correspond to the inventions described above are listed under each Group (see underlined notes).

***Linked Inventions***

Claim 1 link(s) the inventions of claims 2-20; claim 21, the inventions of claims 22-33; and claim 34, the inventions of claims 35-45. The restriction requirement among the linked inventions is **subject to** the nonallowance of the linking claim(s). Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis V. Wollenberger whose telephone number is 571-272-8144. The examiner can normally be reached on M-F, 8 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached on (571)272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LW

September 29, 2007

/Sean McGarry/  
Primary Examiner  
AU 1635